

U.S. Pat. App. Ser. No. 11/220,871
Attorney Docket No. 10191/4476
Reply to Office Action of May 24, 2006

REMARKS

Claims 16 and 17 are canceled without prejudice, and therefore claims 12 to 15 and 18 to 23 are now pending and being considered.

It is noted that the Office Action Summary wrongly refers only to claims 12 to 22 as pending – when in fact claims 12 to 23 were added in the previously filed Preliminary Amendment.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

It is respectfully requested that the Office acknowledge whether the drawings are accepted.

With respect to paragraph eight (8) of the Office Action, Applicants thank the Examiner for indicating that claims 17 and 19 include allowable subject matter. While the rejections of the base claims may not be agreed with, to facilitate matters, claim 19 has been rewritten as an independent claim to include the features of claim 18 and original base claim 12. Claim 12 has been rewritten to include the features of claims 16 and 17, which have been canceled without prejudice. Accordingly, as presented, claims 12 and 19 are allowable, as are the dependent claims 13 to 15, 18, 20, 21 and 22. It is therefore respectfully requested that the objections be withdrawn.

With respect to paragraph five (5) of the Office Action, claims 12 to 15 and 21 to 23 were rejected under 35 U.S.C. § 102(e) as anticipated by Moulsey, U.S. Patent No. 6,407,993.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the

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determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'l. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

As explained above, while the rejections may not be agreed with, to facilitate matters, claim 12 has been rewritten to include the features of claims 16 and 17, which have been canceled without prejudice. Accordingly, claim 12 is allowable, as are its dependent claims 13 to 15, 21 and 22. Claim 23 includes features like those of claim 12 as presented, and is therefore allowable for essentially the same reasons as claim 12 as presented. It is therefore respectfully requested that the anticipation rejections be withdrawn as to claims 12 to 15 and 21 to 23.

With respect to paragraph seven (7) of the Office Action, claims 16, 18 and 20 were rejected under 35 U.S.C. § 103(a) as obvious over Moulsey in view of Hamalainen, U.S. Patent No. 6,289,217.

Claim 16 has been canceled without prejudice, since its features have been included in claim 12 as presented, as explained above. Claims 18 and 20 are allowable since they depend from claim 12 as presented (which includes the features of now canceled claim 16 and claim 17, which the Examiner has indicated has allowable subject matter), and since the secondary reference does not cure the critical deficiencies of the primary Moulsey reference. Accordingly, claims 18 and 20 are allowable, and it is therefore respectfully requested that the obviousness rejections be withdrawn.

It is therefore respectfully submitted that claims 12 to 15 and 18 to 23 are allowable.

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Conclusion

It is therefore respectfully submitted that all of pending and considered claims 12 to 15 and 18 to 23 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Dated: 8/29/06

Respectfully submitted,

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